

### **Remarks**

Applicants have amended claim 1, cancelled claim 41 without prejudice, and renumbered claims 51-69 as claims 42-60. New claim 42 has been amended to be dependent on claim 1. No new matter has been added. Applicants preserve the right to file continuing patent applications on any subject matter that has been cancelled from the claims, including any cancelled claims.

### **Response to Restriction Requirement**

In the restriction requirement, the Examiner had divided the claims into Groups I-IV. In response to the restriction requirement, Applicants elect with traverse Group I, claims 1-42, drawn to compounds of formula I and pharmaceutical compositions thereof. The claims encompassed by Applicants' provisionally elected invention, as defined in Group I, are claims 1-42.

The Examiner alleges that Groups I-IV do not relate to a single inventive concept. Applicants assert that the claims do relate to a single inventive concept and the compounds of Formula I and Formula VII are not known in the art.

First, although a unity of invention objection can be made by the EPO within a single claim, it cannot be made between a dependent claim and the claim from which it depends (EPO Guidelines, C-III). In the instant case, claims 43 and 44 are dependent on claim 1, so there cannot be any lack unity of invention between claims 43-44 and claim 1.

Second, the EPO rules permit claims containing a corresponding special technical feature to be grouped together. The basic theme of current EPO Unity of Invention practice is that all of the independent claims in the same application should be linked by at least one corresponding special technical feature in the claim. The test for unity of invention is whether there is a single general inventive concept. The test is applied by determining if different claims include a common, special technical feature. If this test is met for an application containing a product claim, a claim to a process specially adapted to make the claimed product, and claims to the use of the claimed product, then

all of these claims can be permitted to be in a single application. (See EPO Guidelines C-III, 7.2)

Applicants submit that each of Groups I-IV possess unity of invention. The intermediates of formula VII, which are not known in the art, are the essential structural element found in all of groups I-IV. Formula VII, which is what is made in the process claims of Group III, and what is claimed in Group IV, is an intermediate that is within the final product of the compounds of Formula I in Group I and Group II. Specifically, the compound of formula VII  $[X-S(O)_2-W-O-W]$  corresponds to the  $-SO_2-R^2$  portion of the compound of formula I in Groups I and II, wherein the W-O-W portion of formula VII falls within the scope of  $R^2$ . Moreover, the majority of the specific compounds in claim 14 have groups that fall within the scope of  $S(O)_2-W-O-W$ .

The intermediates in Example 4 of the specification include intermediate compounds within the scope of Formula VII which incorporate this essential structural element into the final product of the compounds within Groups I and II.

In regard to Group IV, claims 55-60, the compounds in these claims relate to the intermediates that fall within the scope of formula VII.

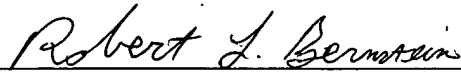
Accordingly, all of Groups I-IV include a common, special technical feature, which is  $S(O)_2-W-O-W$ . All of Groups I-IV should be permitted to be in a single application because group I relates to a product claim; Group III relates to a claim to a process specially adapted to make the claimed product in Group I; Group II claims are dependent on Group I claims and they relate to the use of the claimed product in Group I; and Group IV relate to the intermediates of Group III; and all of groups I-IV share the common technical feature  $S(O)_2-W-O-W$ .

No fees are believed to be due in order to process this document and any paper attached. Should the U.S. Patent Office determine that an extension of time and/or other

relief is required at this time, the Commissioner is authorized to charge the cost of such relief and/or fees to Deposit Account No. 50-1108, referencing EX03-039C-US.

Respectfully submitted,

Date: September 17, 2008

  
Robert L. Bernstein  
Attorney for Applicants  
Registration No. 46,020

Exelixis, Inc.  
*(Physical Address)*  
249 East Grand Avenue  
South San Francisco, CA 94080-4804

*(Postal Address)*  
Post Office Box 511  
South San Francisco, CA 94083-0511

Direct Phone: (650) 837-7352  
Fax: (650) 837-8234